

submitted herewith. Appendix A is a marked-up copy of the amended claim and Appendix B is a clean copy of the amended claim.

**REMARKS**

Claims 1-6 are currently pending in the present application. Claim 1 has been amended in the expectation that the amendment will place this application in condition for allowance. The amendments do not introduce new matter within the meaning of 35 U.S.C. § 132. Accordingly, entry of the amendments is respectfully requested.

**1. Rejection of claims 1-4 and 6 under 35 U.S.C. §102(b)**

Claims 1-4 and 6 have been rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 4,198,782 to Kydonieus et al. In particular, the Official Action states, in relevant part:

Regarding claim 1, Kydonieus teaches a method for protection of germinating seed coated with a pesticide (Col. 4, line 19-22), characterized in the seed-containing pellets and pesticide-containing pellets are sown as individual pellets at the same time (Fig. 4 #15 and 16).

Regarding claim 2, Kydonieus teaches that the pesticide-containing pellets have substantially the same shape and size as the seed-containing pellets (Kydonieus Fig. 4 # 15 and 16).

Regarding claim 3, Kydonieus inherently teaches pesticide-containing pellets comprise a dose of pesticide that is sufficient for one seed germ.

Regarding claim 4, Kydonieus teaches the pesticide-containing pellets contain a filler material (Kydonieus Col. 3, line 68).

Regarding claim 6, Kydonieus teaches a pesticide-containing pellet to be used in the combination with a seed-containing pellet (Kydonieus Col. 3, line 55-62 and Col. 4 line 19-22).

Applicants respectfully traverse this rejection. The test for anticipation is whether each and every element as set forth is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987); MPEP §2131. The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); MPEP §2131. The elements must also be arranged as required by the claim. *In re Bond*, 15 USPQ2d 1566 (Fed. Cir. 1990).

Kydonieus et al. teach a method of controlling agricultural pests by applying a controlled-release pesticide particle to the soil environment of a plant or seed. The pesticide is applied at the surface, or may be intermixed throughout or primarily at a desired depth. In addition, the pesticide may be applied to the plant itself or to the seed as an admixture with the seeds before planting or in the furrow or hole provided for the seed.

In contrast, the presently pending claims relate to a method for the protection of germinating seed, characterized in that seed-containing pellets and pesticide-containing pellets are sown as

individual pellets at the same time. The coating covering the seeds is not a pesticide. In fact, the coating covering the seeds used to form the seed-containing pellets is a critical aspect of the presently claimed invention as it limits the negative effect of the pesticide on the seed during the germination process, or the seed's most vulnerable stage. (See specification page 2, lines 10-12)

Kydonieus only discloses the sowing of the seeds themselves with pesticide-containing granules. Kydonieus does not teach or disclose sowing the seeds as part of a pellet; rather, the naked seeds themselves are sown. Accordingly, Kydonieus does not disclose this critical aspect of the presently pending claims and thus fails to teach each and every claim limitation as required by *Verdegaal Bros. v. Union Oil Co. of California*. As such, the Kydonieus et al. reference does not anticipate the presently claimed invention.

Accordingly, applicants respectfully request the Examiner to reconsider and withdraw the rejection of pending claims 1-4 and 6.

## **2. Rejection of claims 1-6 under 35 U.S.C. §103(a)**

Claim 5 has been rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 4,198,782 to Kydonieus et al. Claims 1-6 have been rejected under 35 U.S.C. §103(a) as being

unpatentable over Canadian Patent No. 1143651 to Lemon in view of U.S. Patent No. 4,198,782 to Kydonieus et al.

In particular, the Official Action states, in relevant part:

Regarding claim 5, Kydonieus discloses that the pesticide-containing pellets and the seed-containing pellets have a substantially uniform diameter (Fig. 4 #15 and 16), but is silent on the range from 0.5-5mm. However, it would have been obvious to one of ordinary skill in the art to modify the teachings to accommodate different seed varieties.

Regarding claim 1, Lemon teaches a method for protection of germinating seed, characterized in the seed-containing pellets and pesticide-containing pellets are sown as individual pellets at the same time (Lemon, page 1, line 9, 10, 13; page 2 line 14-15; page 3 line 11-15). Lemon is silent on the seed being coated with pesticide. However, Kydonieus teaches a seed coated with pesticide (Kydonieus, Col. 4, line 20-21). Furthermore, it is old and notoriously well-known in the art of plant husbandry to coat seeds with pesticide. It would have been obvious to one of ordinary skill in the art to modify the teachings of Lemon for the enhanced effect of the additional pesticide to further fight pests.

Regarding claim 2, Lemon teaches that the pesticide-containing pellets have substantially the same shape and size as the seed-containing pellets (Lemon page 1 line 9-10).

Regarding claim 3, Lemon teaches pesticide-containing pellets comprise a dose of pesticide that is sufficient for one seed germ (Lemon page 1, line 13-19).

Regarding claim 4, Lemon teaches the pesticide-containing pellets contain a filler material (Lemon page 4 line 20-22).

Regarding claim 5, Lemon discloses that pesticide-containing pellets and the seed-containing pellets have a substantially uniform diameter from 0.5-5mm (Lemon page 3 line 25).

Regarding claim 6, Lemon teaches a pesticide-containing pellet to be used in the combination with a seed-containing pellet (Lemon page 1 line 9, 10, 13; page 2 line 14-15; page 3 line 11-15).

Applicants respectfully traverse these rejections. The references of record do not teach or suggest applicants' inventive subject matter as a whole as recited in the claims. The Examiner has failed to establish a *prima facie* case of obviousness against the presently rejected claims.

To establish a *prima facie* case of obviousness, the PTO must satisfy three requirements. First, the prior art relied upon, coupled with the knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference. *In re Fine*, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Second, the proposed modification of the prior art must have had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was made. *Amgen Inc. v. Chugai Pharm. Co.*, 18 USPQ2d 1016, 1023 (Fed. Cir. 1991). Lastly, the prior art references must teach or suggest all the limitations of the claims. *In re Wilson*, 165 USPQ 494, 496 (C.C.P.A. 1970).

#### **A. Present Inventive Subject Matter**

The presently pending claims relate to a method for the

protection of germinating seed, characterized in that seed-containing pellets and pesticide-containing pellets are sown as individual pellets at the same time. The coating covering the seeds is not a pesticide. In fact, the coating covering the seeds used to form the seed-containing pellets is a critical aspect of the presently claimed invention as it acts as a shield to limit the negative effect of the pesticide on the seed during the germination process, or the seed's most vulnerable stage. (See specification page 2, lines 10-12)

#### **B. Disclosure of the Primary Reference**

In contrast, Lemon discloses a mixture of brassica seed and granules containing bendiocarb (i.e. pesticide), particularly where the seed and granules are of similar size and density. Lemon does not disclose a seed-containing pellet as required by the presently pending claims.

#### **C. The Secondary Reference does not teach the seed-containing pellet as required by the Presently Pending Claims**

Kydonieus et al. do not remedy this deficiency. Kydonieus et al. teach a method of controlling agricultural pests by applying a controlled-release pesticide particle to the soil environment of a plant or seed. The pesticide is applied at the surface, or may be intermixed throughout or primarily at a desired depth. In

addition, the pesticide may be applied to the plant itself or to the seed as an admixture with the seeds before planting or in the furrow or hole provided for the seed. Kydonieus et al. do not disclose a seed-containing pellet as required by the presently pending claims.

Applicants, therefore, respectfully submit that the combination of the references would still not achieve the presently claimed subject matter since the combination would not include the critical limitation of the seed-containing pellet. As such, Applicants submit that the Examiner has failed to meet the burden of proving a *prima facie* case of obviousness, and the claims are not obvious over the references.

In summary, Applicants submit that the combination of references asserted by the Examiner fails to teach or suggest the presently claimed invention having a seed-containing pellet. Thus, the presently claimed invention is unobvious over the cited references. Accordingly, applicants respectfully request the Examiner to reconsider and withdraw the rejection of pending claims 1-6.

#### CONCLUSION

Based upon the above remarks, the presently claimed subject matter is believed to be novel and patentably distinguishable over the prior art of record. The Examiner is therefore respectfully

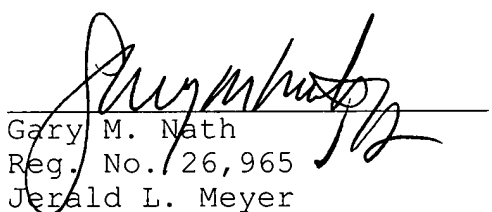
requested to reconsider and withdraw the rejections of pending claims 1-6. Favorable action with an early allowance of the claims pending in this application is earnestly solicited.

If the Examiner has any questions or wishes to discuss this application, kindly telephone the undersigned at the below-listed number.

Respectfully submitted,

**NATH & ASSOCIATES PLLC**

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